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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,846	08/07/2001	Yuichiro Itakura	880-24-026	2166

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,846

Applicant(s)

Itakura et al

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-63 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 7, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed August 20, 2002 (Paper No. 6) is acknowledged.
2. Additionally, the preliminary amendment (Paper No. 4) filed with the application is also acknowledged. Accordingly, claims 56-63 remain pending.

Restriction

3. Applicants' election of Invention II (claims 56-63) in Paper No. 6 is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP §818.03(a)).

Election of Species

4. Applicants' election with traverse of A1, B1, and C3 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "the Examiner would effectively penalize the inventors for providing a thorough and lengthy disclosure." Additionally, Applicants state "the figures of Species A, B, and C by no measure disclose the claimed invention of claims 56-63." Because of these statement by Applicants, the election of species is hereby withdrawn.

The Examiner notes that if Applicants later present claims to patentably distinct species, the Election of Species may be reinstated at that time.

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Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

6. The Examiner notes that Applicants have checked the box indicated a second page of inventors yet the declaration does not contain a second page. Appropriate correction is required.

Specification

7. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. First, it is unclear as to why Applicants are incorporating by reference the foreign applications.

If Applicants desire to incorporate essential material by reference, Applicants are required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179

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USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Alternatively, if the incorporation by reference is relied upon only to establish an earlier effective filing date, this objection to the specification will be withdrawn. The Examiner respectfully requests Applicants clarification as to why Applicants are incorporating the foreign material by reference. See MPEP §608.01(p).

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

- a. The “receiving an order receipt” as recited in claim 56.
- b. The “querying the database” as recited in claim 56.
- c. The “performing a first pre-defined on-line action” as recited in claim 59.

9. The Examiner notes the claims are replete with the above drawing errors. All method steps recited in claims 56-63 are clearly not shown in the drawings. The Examiner highly recommends Applicants review all eight claims to ensure that every method step recited is shown in the drawings. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claim 56, 57, 59, 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Teicher (U.S. 5,206,488). Teicher discloses an existing or traditional credit card system since Teicher's system is designed to work with existing systems (column 3, lines 7-13). Teicher discloses the following: a credit card system (the credit card system includes a debit card, column 1, lines 18 and 19); receiving an order receipt from an on-line merchant (standard validation of a credit card transaction); the order receipt including the amount (inherent in all credit card authorizations); querying the database to determine the value of the parameter assigned to the given registered user (querying to see if the customer has enough money in their account to make the purchase, again, a standard credit card transaction element); if the assigned value (available credit) is at least as much as the needed amount (amount of purchase), then transmitting a payment

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acceptance response (approved); subtracting the needed amount from the value of the parameter assigned to the given registered users (decrementing the user's available credit); storing in the database information about a credit card account of the register (inherent in name, credit card account number, expiration date, billing address, credit limit, available credit balance, etc.); if the assigned value is less than the needed amount, then using a conversion of the parameter to an actual currency (dollars) to charge the credit card account an actual currency equal to the difference between the assigned value and the needed amount (a negative balance, if the purchase greater than the user's balance in a debit account, a negative balance would result; this limitation is alternatively met by the local and master system); performing a first predefined on-line action, increasing the value of the parameter assigned to the given user a first predefined amount (inherent, the credit card company performing an increase in credit limit by a first amount); and performing a second predefined on-line action, increasing the value of the parameter assigned to the given user a second predefined amount (inherent, the credit card company performing an increase in credit limit by a second maximum amount).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher in view of Fulton et. al. (U.S. 6,182,052 B1)("Fulton"). Teicher discloses as discussed above but does not directly disclose overdraft protection. Fulton teaches the concept of overdraft protection (column 7, lines 17 and 18) to protect an account from exceeding a set balance.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Teicher as taught by Fulton to include overdraft protection. Such a modification is old and well known in the art. Additionally, it would have helped consumers from proffering bad checks (a criminal violation) by deducting the needed amount from a second account).

14. Claim 61-63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher in view of Barnett et. al. (U.S. 6,321,208 B1)("Barnett"). Teicher discloses as discussed above but does not directly disclose an online advertisement system with a message and response. Barnett teaches an online advertisements system with a particular online message (the ad) and the user using the device to response (inherent, the user closing out the advertisement, a response nevertheless).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Teicher as taught by Barnett to include an online advertisement system with a message and response. Such a modification would have helped the internet service provider reduce customer access fees to help increase online shopping.

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15. Functional recitation(s) using the word “for” (e.g. “for an on-line purchase by the given registered user” as recited in claim 56) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

16. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60

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In accordance with the ordinary and accustom meaning presumption, the claims are interpreted during examination with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).²

However, if Applicants do desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicants in their next response to expressly³ indicate the claim limitation at issue⁴ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly

USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

³ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted).

⁴ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁵ The Examiner cautions that no new matter is allowed.

Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Applicants are cautioned that even though claim interpretation begins with this presumption, the prosecution history may further limit claim scope if Applicants disclaim or

⁵ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[a] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

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disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002).

17. It is the Examiner's position that all claimed features in claims 56-63 are either disclosed or inherent in the references discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Ittakura et. al. (U.S. 6,351,745 B1); Harms et. al. (U.S. 6,070,147); Ogram (U.S. 5,991,738); Fredregill et. al. (U.S. 5,923,016); Storey (U.S. 5,774,870); Burton et. al. (U.S. 5,025,372); and Case et. al. (U.S. 4,172,552).

19. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

20. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicants with notice—for due process purposes—of his position

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regarding his factual determinations and legal conclusions. If Applicants disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied⁶, the Examiner respectfully requests Applicants *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER

AJF
November 4, 2002

⁶ E.g., if the Examiner rejected a claim under §103, although not directly stated, it is the Examiner's implied position that the references are analogous art.